



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: K. Hachiya et al.)
Serial No.: 08/992,770)
Title: METHOD AND APPARATUS FOR) Examiner: Thong H. Vu
AUTOMATIC SENDING OF E-MAIL)
AND AUTOMATIC SENDING) Group Art Unit: 2152
CONTROL PROGRAM SUPPLYING)
MEDIUM)
Filing Date: December 17, 1997)
Case No.: 114243-004)

RECEIVED

NOV 12 2002

OFFICE OF PETITIONS

Box AF
Assistant Commissioner for Patents
Washington, DC 20231

PETITION TO WITHDRAW APPLICATION FROM ISSUE UNDER 37 C.F.R. §1.313

Sir:

Applicants respectfully request that the above identified patent application be withdrawn from issue. This petition is accompanied by a check in the amount of \$130.00 as set forth in 37 C.F.R. §1.17(a). However, for the reasoning set forth below, Applicants believe the petition fee should be returned to them, because the need to petition the office to withdraw the application from issue arose due to an error at the Patent Office and was not occasioned by any action of the Applicants.

The events which transpired to cause the current situation are as follows. On July 31, 2002 Applicants' attorney, Jeffrey H. Canfield (38,404) received a telephone communication from Examiner Thong Vu regarding the application. The Examiner indicated that except for claims 99,116 and 123, the case was in condition for allowance. The Examiner suggested entering an Examiner's Amendment canceling claims 116 and 123, and combining the limitations of claim 100, 101, 102, 103 and 104 into claim 99 to get the case allowed.

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Applicants' attorney responded that he would need client approval to make the suggested changes, and that he would get back to the Examiner later.

Upon communicating the Examiner's proposed changes to the Applicants' local attorney in Japan, Mr. Canfield received an indication that the proper authority to approve the changes would not be available until August 5, 2002. This was relayed to the Examiner who agreed to the delay. On August 5, 2002 Mr. Canfield received faxed instructions from Applicants' Japanese counsel that the suggested changes were unacceptable and that Applicants desired to continue prosecuting the rejected claims. This information was relayed via a telephone message to Examiner on August 5, 2002. A report of the telephone call was faxed back to the Applicants Japanese attorney the same day. A copy of this communication summarizing the communication with the Examiner is included with the present petition as an attachment.

Apparently the Examiner ignored the instructions given him via voice mail. A Notice of Allowability was mailed on August 13, 2002. The Notice of Allowability included an Examiner's Amendment canceling claims 99-104, 116 and 123 which was supposedly based upon the Examiner's communication with Mr. Canfield on August 5, 2002. An interview summary of the August 5, 2002 conversation prepared by the Examiner was also attached to the effect that Applicants' attorney agreed to the changes included in the Examiner's Amendment.

The Examiner's summary of the August 5, 2002 telephone interview directly contradicts the Applicants' attorney's record of the substance of that interview. According to Applicants' attorney's records, the Examiner should have issued an Office Action rejecting any claims that were found unpatentable or he should have issued all of the claims as they stood prior to the telephone interview.

Based on the above facts, Applicants respectfully submit that the Notice of Allowance was entered in error and that the application should be withdrawn from issue. Applicants respectfully request that the Examiner act on the case, with the claims as they stood prior to the Examiner's Amendment.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY Jeff H. Canfield
Jeffrey H. Canfield
Reg. No. 38,404
P.O. Box 1135
Chicago, Illinois 60690-1135
Phone: (312) 807-4233

BELL, BOYD & LLOYD LLC
P.O. Box 1135
Chicago, Illinois 60690-1135
(312) 807-4233

BELL, BOYD & LLOYD LLC

JEFFREY H. CANFIELD
312.807.4233
jcanfield@bellboyd.com

FILE
1000 FIRST NATIONAL PLAZA
70 WEST MADISON STREET, SUITE 3300
CHICAGO, ILLINOIS 60602-4207
312.372.1121 FAX 312.372.2098

OFFICES IN CHICAGO
AND WASHINGTON, D.C.



August 5, 2002

Mr. Yuichi Murakami
Patent Attorney
PRIMEWORKS
2-17-16, Ebisu-Nishi, Shibuya
Tokyo, 150-0021, Japan

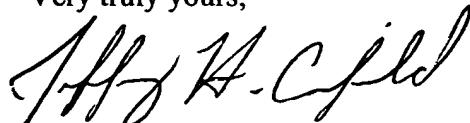
Re: Your Reference No.: S97P1135US00 Hachiya et al. application for patent filed
December 17, 1997, USSN 08/992,770
Our Case No.: 112857-118

Dear Mr. Murakami:

Thank you for your faxed letter of August 2, 2002. I have communicated with the Examiner and told him that we do not agree with his suggested amendments and that he should issue an Office Action if he does not believe the claims are allowable as they stand.

We will formulate an appropriate response upon receiving the Office Action.

Very truly yours,


Jeffrey H. Canfield

JHC:cyl



TRANSMITTAL LETTER
(General - Patent Pending)

Office of Petitions
Docket No.
114243-004

In RE: Application Of: K. Hachiya et al.

Serial No.
08/992,770

Filing Date
12/17/97

Examiner
Thong H. Vu

Group Art Unit
2152

Title: **METHOD AND APPARATUS FOR AUTOMATIC SENDING OF E-MAIL AND AUTOMATIC SENDING CONTROL PROGRAM SUPPLYING MEDIUM**

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

Transmitted herewith is:

Petition to Withdraw Application from Issue Under 37 C.F.R. §1.313 (4 Pages); Check in the Amount of \$130.00; and Return Receipt Postcard.

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NOV 12 2002

OFFICE OF PETITIONS

in the above identified application.

No additional fee is required.
 A check in the amount of \$130.00 is attached.
 The Commissioner is hereby authorized to charge and credit Deposit Account No. 02-1818 as described below. A duplicate copy of this sheet is enclosed.
 Charge the amount of
 Credit any overpayment.
 Charge any additional fee required.

Signature

Jeffrey H. Canfield, Esq. (38, 404)
Bell, Boyd & Lloyd LLC
P.O. Box 1135
Chicago, Illinois 60690-1135
Telephone: (312) 807-4233

Dated: October 31, 2002

I certify that this document and fee is being deposited on Oct. 31, 2002 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Signature of Person Mailing Correspondence

Robert J. Buccieri

Typed or Printed Name of Person Mailing Correspondence

CC: